



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/500,332

07/21/2004

Renato Ancorotti

3687-70

8959

23117

7590

07/22/2009

NIXON & VANDERHYE, PC

901 NORTH GLEBE ROAD, 11TH FLOOR

ARLINGTON, VA 22203

EXAMINER

AHMED, HASAN SYED

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

07/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,332

Applicant(s)

ANCOROTTI, RENATO

Examiner

HASAN S. AHMED

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42, and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- Receipt is acknowledged of applicant's amendment and response filed on 8 September 2008.
- The 35 USC 103 rejection over Hempel is withdrawn in view of the amendment.

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 19, 21, 24, 25, 27-30, 32, 35, 36, 38-40, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,994,264 ("Verdon").

Verdon, et. al. teach a method of making a press molded cosmetic composition (see col. 1, line 67 – col. 2, line 2) comprising:

- the fatty emulsion (solvent and fats) of instant claims 18(a'), 29(a'), 42(a'), and 43(a') (see Example, col. 4, line 65 – col. 5, line 23; Example, col. 4, line 65 – col. 5, line 23) with water as a solvent (see col. 2, lines 3-4);
- the pearly, synthetic, and natural pigments and inert powders of instant claims 18(a''), 29(a''), 42(a''), and 43(a'') (see col. 3, lines 54-61 and example);

- the mixing of instant claims 18(b), 29(b), 42(b), and 43(b) (see Example, col. 4, line 65 – col. 5, line 23) with a fatty emulsion to coloring powders proportion of about 50/50% by weight (see col. 6, line 20);
- the extruding of instant claims 18(c), 29(c), 42(c), and 43(c) (see Example, col. 4, line 65 – col. 5, line 23);
- the drying of instant claims 18(d), 29(d), 42(d), and 43(d) (see col. 4, lines 32-36);
- the stearate of instant claims 19 and 30 (see Example, col. 4, line 65 – col. 5, line 23);
- the preserving agents of instant claims 21 and 32 (see col. 3, lines 63-66);
- the extruder of instant claims 24 and 35 (see col. 4, line 28);
- the drying temperature and humidity of instant claims 26 and 37 (see col. 4, lines 34-36);
- the cosmetic of instant claims 27 and 38 (see Example, col. 4, line 65 – col. 5, line 23);
- the blusher or eye shadow of instant claims 28 and 39 (see col. 1, line 17);
and
- the sizing of instant claims 40, 42, and 43 (see col. 4, lines 11-13).

The paste is extruded at a temperature of about 10 of 35 degrees Celsius in a standard cosmetic powder compression molding device under standard cosmetic powder molding conditions followed by drying at a temperature of 40 to 55 degrees Celsius (see col. 4, lines 28-35).

Verdon explains that the disclosed invention is beneficial because it avoids the disadvantages of loose powder, such as messiness, spillage, etc. (see col. 1, lines 11-14).

The Verdon reference does not explicitly recite the oven of instant claims 25 or 36, or the temperature and humidity ranges of claims 18, 29, 42, and 43. However, it recites drying at temperatures of about 40-55 degrees Celsius with a final moisture content of about 0.25 to 7% (see col. 4, lines 34-36). It is inherent that the molded composition would only be dried at such high temperatures in an oven.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose process of making a make-up cosmetic comprising mixing a fatty emulsion and coloring powders, extruding the resulting paste, drying and sizing the extruded product, as taught by Verdon. One of ordinary skill in the art at the time the invention was made would have been motivated to use such a process because it results in a product which does not have the disadvantages of loose powder, as explained by Verdon.

* * * * *

Response to Arguments

Applicant's arguments filed on 13 April 2009 have been fully considered but they are not persuasive.

1. Applicant argues that the solvent used instantly is water while Verdon discloses a slurry including a polar solvent (see remarks, page 8, 2nd full-paragraph).

Examiner respectfully submits that instant claims 18(a'), 29(a'), 42(a'), and 43(a') use the transitional term "comprising", which is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See MPEP 2111.03. Further, Verdon discloses a water content as high as 60% (see col. 2, line 3), while the polar solvent concentration may be *de minimus*, i.e. as low as 0.01% (see col. 2, line 8).

2. Applicant argues that Verdon discloses fatty liquid compounds in the Example at col. 4, line 60 onwards (see remarks, page 8, 2nd full-paragraph).

Examiner respectfully submits that the claims, as currently drafted, do not preclude fatty liquids; rather, the claims recite fatty liquids, e.g. seed oil derivatives (claim 18), olive oil (claim 19), etc.

3. Applicant argues that Verdon's cosmetics need to be molded in a compression molding machine (see remarks, page 8, 5th full-paragraph).

Verdon teaches extrusion of a paste in a standard cosmetic powder compression molding device (see col. 4, lines 28-31), followed by drying at a temperature of about 40 to 55 degrees Celsius (see col. 4, line 34). The instant claims, as currently drafted, only require extruding the paste to obtain an extruded product directly followed by a drying step. Since the extrusion in Verdon occurs in the compression molding device, the molding is not a separate step which follows extrusion, rather, molding occurs during extrusion, and the drying step immediately follows the extrusion.

Further, the instant claims do not preclude extrusion in a powder compression molding device. As in Verdon, the instant application discloses solid compositions that can be produced in different formats (see published application, [0007]) and shapes (see published application, [0054]).

Finally, as indicated previously, applicant does not provide a special definition of "non-pressed powder." As such, examiner respectfully submits that the "press molded" composition of Verdon reads on the composition of the instant application after it has been extruded.

* * * * *

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

★

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./
Examiner, Art Unit 1615

/Humera N. Sheikh/
Primary Examiner, Art Unit 1615